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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

12 | OVERTURE SERVICES, INC.,

Case No. C 02-01991 JSW (EDL)

13 Plaintiff and Counterdefendant,

GOOGLE INC.'S CLAIM CONSTRUCTION SUR-REPLY (REDACTED VERSION)

15 | GOOGLE INC.,

Tutorial: March 10, 2004, 2:00 p.m.
Hearing: March 24, 2004, 2:00 p.m.
Courtroom: 2, 17th Floor
Judge: Hon. Jeffrey S. White

16 | Defendant and Counterclaimant.

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1 Pursuant to the Court's Order Re: Google's Miscellaneous Administrative Request Re:
 2 Overture's Revised Claim Constructions (filed February 6, 2004), Defendant Google Inc.
 3 ("Google") hereby submits the following Sur-Reply in support of its proposed constructions of
 4 the terms "search result list" and "search listing."

5 **SUR-REPLY**

6 As an initial matter, Overture misstates Google's position on whether a "search result
 7 list" may include paid listings. Neither Google's proposed definitions of "search listing" nor
 8 "search result list" limit "responsive" information to unpaid listings. The parties' dispute is
 9 whether the proposed definition of search result list must include some reference to the concept
 10 of "search." Google's construction makes clear that a search result list does not encompass all
 11 types of data or information that is returned to the user in reaction to the user's input, such as
 12 banner ads, but that the information must be responsive to what the searcher was searching for.¹
 13 Overture's definition does not, and it is that failure to capture the concept of "search" with which
 14 Google takes issue.

15 As in its Opening Brief, Overture insists that its proposed constructions – which are
 16 derived solely from dictionary definitions – are the "ordinary meanings" of the terms. But the
 17 Federal Circuit has explained that the ordinary meaning is not limited to what can be gleaned
 18 from common purpose dictionaries. Rather, the "ordinary meaning" is the "meaning [of the
 19 term] to a person of ordinary skill in the art." *See Combined Systems, Inc. v. Defense Tech.*
 20 *Corp.*, 350 F.3d 1207, 1216, fn. 6 (Fed. Cir. 2003) (emphasis added). Accordingly, the Court
 21 should not only look to dictionaries as an *aid* to determining the ordinary meaning of claim
 22 terms, but must also review the intrinsic evidence such as the specification, the drawings, and the
 23 prosecution history. *See id.* at 1210, 1215-1216; *see also Golight, Inc. v. Walmart Stores, Inc.*,
 24 355 F.3d 1327, 1331 (Fed. Cir. 2004) ("claims *must* be construed in light of the specification")

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 26 ¹ Although the idea of a user searching for paid listings as opposed to neutral results may, at first
 27 blush, seem counterintuitive, the specification explains that the claimed invention includes
 28 search engines wherein the searcher is specifically looking for paid listings. *See, e.g.*, 3:58-62
 ("A consumer utilizing a search engine that facilitates this on-line marketplace will find
 companies or businesses that offer the products, services, or information that the consumer is
 seeking.").

1 (emphasis added). As the Federal Circuit recently warned, “[i]f . . . the district court believe[s]
 2 that our cases permit consulting the specification solely for the limited purpose of determining
 3 whether it contradicts the dictionary meaning of a claim term, such view is not supported by our
 4 case law, read as a whole.” *Combined Systems, Inc.*, 350 F.3d at 1215-1216.

5 But that is precisely the approach that Overture urges here. Indeed, a careful review of
 6 Overture’s briefing on the issue of whether a “search result list” must be responsive to a
 7 searcher’s search demonstrates that Overture does not, even once, refer to the specification or
 8 any other intrinsic evidence in its claim construction analysis. Rather, Overture blithely
 9 concludes that its proposed constructions are correct because they are taken from dictionaries,
 10 *see, e.g.*, Reply at 4, fn. 3 (explaining that the ordinary meaning of “search” requires
 11 “examination” as defined by Random House and Webster’s), and then improperly puts the onus
 12 on Google to justify its reliance on the specification.

13 Overture’s criticism is unwarranted. The Federal Circuit teaches that “where there are
 14 several common meanings for a claim term, the patent disclosure serves to point away from the
 15 improper meanings and toward the proper meaning.” *Renishaw PLC v. Marposs SpA*, 158 F.3d
 16 1243, 1250 (Fed. Cir. 1998); *see also Texas Digital Sys. v Telegenix, Inc.*, 308 F.3d 1193, 1203
 17 (Fed. Cir. 2002) (court should look for the definition that is “is most consistent with the use of
 18 the words by the inventor.”).

19 *First*, Google’s proposed constructions are consistent with dictionary definitions. For
 20 example, the Random House Dictionary of the English Language (2d ed., 1997) defines “search”
 21 as “to examine . . . to locate *specific items*.” *See Ex. 6* to Overture’s Opening Claim
 22 Construction Brief, Vol. 1. (emphasis added). Similarly, Webster’s New World College
 23 Dictionary (3d ed. 1997) provides the definition, “to examine data in a computer in order to
 24 locate items *having a given property*.” *Id.* (emphasis added). Accordingly, Google’s definition
 25 of “search result list,” which includes the concept of returning results that are in fulfillment of a
 26 user’s examination for *specific items* or *having a given property*, is consistent with the very
 27 dictionaries upon which Overture relies.

28 *Second*, the specification clarifies a “search result” does not include responses that are

1 not responsive to the searcher's search for specific information. As explained in the
 2 specification, search engines "enable consumers to search the Internet for a listing of web sites
 3 based on a *specific* topic, product, or service of interest." 2:33-35 (emphasis added); *see also*
 4 3:63-65 3:58-62 ("A consumer utilizing a search engine that facilitates this on-line marketplace
 5 will find companies or businesses that offer the products, services, or information *that the*
 6 *consumer is seeking.*") (same); 10:6-21 ("A second class of users at client computers may
 7 comprise searchers seeking *specific* information on the web. . . .) (same).

8 Overture's proposed construction of "search result" is flatly inconsistent with the use of
 9 the term by the inventors of the '361 because it encompasses banner ads, which the written
 10 description distinguishes as the prior art on the basis that banner ads "fail[] to effectively deliver
 11 *relevant* information via the World Wide Web to interested parties in a cost-effective manner."
 12 3:42-45 (emphasis added); *see also* 3:33-37 (in banner advertising, "[w]eb site promoters are
 13 therefore paying for exposure to many consumers who are not interested in the product or service
 14 being promoted, as most visitors to a web site seek specific information and may not be
 15 interested in the information announced in the banner."). Where the specification expressly
 16 distinguishes prior art on the ground that the prior art does not incorporate an element, it is
 17 improper to then re-incorporate that element at the claim construction stage. *See Sunrace Roots*
 18 *Enterprise Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1305 (Fed. Cir. 2003) (citing *SciMed Life*
 19 *Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1343-44 (Fed. Cir.
 20 2001)).

21 To the extent that Overture contends that banner ads cannot constitute a search result list
 22 because they are not in a "series," it is wrong. Nothing in the specification suggests that banner
 23 ads are limited to a "single" advertisement.

24 [REDACTED]

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 27 Accordingly, since Overture seems to have conceded that
 28 banner ads are obtained as a consequence of the examination of data, and as shown above,

1 banner ads may be arranged in a “series,” Overture’s proposed construction of “search result list”
2 improperly encompasses the prior art that the specification explicitly excluded from the scope of
3 the term.

4 Google’s proposed construction of “search result list” is consistent with the ordinary
5 meaning of the terms, as defined from the relevant dictionary definitions. Although Google’s
6 construction may arguably be somewhat narrower than some of the dictionary definitions that
7 Overture cites, it is the “most consistent” with the use of the term “search result” by the ’361
8 inventors. *See Texas Digital*, 308 F.3d at 1203; *Cf. Sunrace Roots Enterprise Co.*, 336 F.3d at
9 1302 (refusing to import limitations from the specification where the parties agreed on the
10 ordinary meaning of the term).

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12 Dated: February 20, 2004

KEKER & VAN NEST, LLP

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By: _____ /s/ Christine P. Sun

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Counterclaimant GOOGLE INC.

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